

REMARKS

The Applicant notes with appreciation the Examiner's thorough review of the present application as evidenced by the Office Action. Reconsideration is requested in light of the foregoing amendments to the claims and the following remarks. Following the amendments, claims 22-31 remain in the application.

The Claims

Claims 22-31 were filed by preliminary amendment in this continuation application.

In independent claim 22, after the phrase "with its respective shell holder" insert the phrase – said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures movable one with respect to the other –. Also, in the final paragraph of claim 22, replace "one" with – **two** – and replace "assembly" with – **assemblies** –.

In dependent claim 23, amend the phrase "wherein said axial positioning" by adding the phrases – **each of** – and – **at least two** – such that the amended phrase reads – **wherein each of said at least two axial positioning** –. Also, replace "assembly" with – **assemblies** –.

In independent claim 27, replace the phrase "A mold shell" with – **An article** –. In the next paragraph, replace the phrase "a cavity defining" with – **a mold shell containing an impression of** –. Also, in the next paragraph of claim 27, replace the phrase "one male or female" with – **two** –, replace the singular "member" with the plural – **members** –, and replace the phrase "the mold shell" with the phrase – **said mold shell** –. Also, replace the phrase "by meshing with a complementary male or female coupling member in any device employed to support said mold shell during the molding process" with the following phase: – **with respect to a mold shell holder, said shell holder defining a cavity for receiving said mold shell such that said mold shell is in at least partial mutual thermal-conduction contact with said shell holder, said shell holder being shaped to be supported by one of a pair of mold carriers made in the form of enveloping structures movable one with respect to the other** –.

In dependent claim 28, replace the term “mold shell” with the word – **article** – and replace the phrase “defining cavity” with the word – **impression** –.

In dependent claim 29, replace the term “mold shell” with the word – **article** – and replace the phrase “wherein said male or female” with the phrase – **wherein each of said at least two** –. Also, replace the singular “member” with the plural – **members** –.

In dependent claim 30, replace the term “mold shell” with the word – **article** – and amend the phrase “the neck portion of the mold shell” by replacing the first article “the” with the word – **a** – and the second “the” with the word – **said** – such that the amended phrase reads – **a neck portion of said mold shell** –.

In dependent claim 31, replace the term “mold shell” with the word – **article** –. Then, after the word “comprising” insert a colon, a hard return, and the phrase – **a parting face adjacent a generally mating face of said shell holder; and** –, followed by a hard return. Also, amend the final phrase “the parting face of said mold shell” by replacing the article “the” with the word – **said** – and by deleting the phrase “of said mold shell” such that the amended phrase reads – **said parting face** –.

The Section 102(b) Rejection

In the Office Action, claims 22, 23, 26, and 27-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,857,660 to *Flynn et al.* Independent claim 27 has been canceled.

Independent claims 22 and 27 have been amended to include at least two axial positioning assemblies. The patent to *Flynn et al.* does not disclose an embodiment with a second axial groove or ridge and, therefore, does not anticipate the claimed invention.

The Section 103(a) Rejections

In the Office Action, dependent claim 24 was rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over *Flynn et al.* in combination with U.S. Patent No. 3,632,249 to *Pearson*. Independent claims 22 and 27 have been amended to include at least two axial positioning assemblies. Neither *Flynn et al.* nor *Pearson* discloses or suggests including at least two axial positioning assemblies. Because claim 24 depends from claim 22, which has been amended to include a non-obvious claim limitation, dependent claim 24 is not obvious.

Also, in the Office Action, dependent claim 25 was rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over *Flynn et al.* in combination with French Patent No. 2,659,265. Independent claims 22 and 27 have been amended to include at least two axial positioning assemblies. Neither *Flynn et al.* nor the French patent discloses or suggests including at least two axial positioning assemblies. Because claim 25 depends from claim 22, which has been amended to include a non-obvious claim limitation, dependent claim 25 is not obvious.

The Recapture Rejection

In the Office Action, the Examiner rejected all claims (22-26 and 27-31) under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner asserts, “the absence of [1] the mold carriers being in the shape of enveloping structures, [2] the at least one quick-fixing means and [3] in the case of claim 27 the shell holders from these claims constitutes recapture.” (internal numbering added).

[1] First, as explained below, the shape limitation once added to distinguish the prior art in the original prosecution has not been removed from the reissue claims, so there is no recapture attempt in reissue claims 22-26.

[2] Second, no subject matter related to the quick-fixing means was surrendered during prosecution of the original patent application, so without any surrendered subject matter, there can be no recapture attempt in reissue claims 22-26.

[3] Third, claims 27-31 have been amended to restore the shape limitation added to distinguish the prior art in the original prosecution.

[1] The Shape Limitation

The Examiner cites *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997); however, by failing to apply the detailed test set forth in *In re Clement*, the Examiner has improperly denied the Applicants all possibility of adding subcombination claims in this reissue application.

The Applicants traverse this recapture rejection and will respond below by (1) detailing their position on the law of recapture, (2) pointing out the Office’s published position on statutory category broadening in a reissue application, and then (3) applying the appropriate tests to the limitations of the present reissue claims.

The Recapture Test

MPEP Section 1412.02 “Recapture of Canceled Subject Matter” sets out a two-step test based on *In re Clement*, and also cites the rule of *In re Clement* for “[r]eissue claims that are

broader in scope in certain aspects, and narrower in others vis-à-vis claims canceled from the original application to obtain a patent.” (MPEP at p. 1400-15). The first step is to determine whether and in what respect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. The court in *In re Clement* included in the term “surrendered subject matter” the “original application claims as they stood prior to being amended or canceled.”

When a reissue claim is broader in some aspects and narrower in others when compared to a “surrendered” original application claim, the court stated:

- (a) if the reissue claim is as broad as or broader [than the surrendered claim] in an aspect germane to a prior art rejection, but narrower [than the surrendered claim] in another aspect completely unrelated to the rejection, the recapture rule bars the claim;
- (b) if the reissue claim is narrower [than the surrendered claim] in an aspect germane to [a] prior art rejection, and broader [than the surrendered claim] in an aspect unrelated to the rejection, the recapture rule does not bar the claim, . . .

Thus, one must carefully consider what limitations remain in the reissue claim to distinguish the prior art, and how the reissue claim actually differs from the surrendered claim prior to amendment.

Reissue Claims in Corresponding Statutory Categories

One way in which a reissue claim can be broadened is to recast it in a different statutory category. MPEP Section 1412.02 includes a section entitled “Reissue for Article Claims Which are Functional Descriptive Material Stored on a Computer-Readable Medium,” (MPEP at p. 1400-15), which states:

A patentee may file a reissue application to permit consideration of article of manufacture claims which are functional descriptive material stored on a computer-readable medium, where these article claims correspond to the process or machine claims which have been patented. The error in not presenting claims

to this statutory category of invention (the “article” claims) must have been made as a result of error without deceptive intent. The addition of these “article” claims will generally be considered to be a *broadening* of the invention . . . (underlining added).

As an example, consider a patented process claiming steps carried out by software (receiving data, creating an instruction, operating a device responsive to the instruction) and the corresponding article claim (a computer-readable medium having computer-executable instructions for performing steps comprising: receiving data, creating an instruction, operating a device responsive to the instruction). Note that to infringe the article claim, one need only record the computer-executable instructions on a medium – one need not actually perform the steps. The ability to cause a computer to perform the steps is only a characteristic of the recorded instructions, but that characteristic distinguishes the prior art in a way that corresponds to the steps of the process. In this example, if the step of operating a device had been added to the process claim to overcome a prior art rejection, surely the broadening reissue to add the article claim would still be permitted, because the broadening is in an aspect (changing statutory category) unrelated to the rejection.

Of course, broadening by recasting an invention in a different statutory category is subject to the recapture doctrine. But, one cannot conclude that an Applicant surrendered the ability to claim the invention via a different statutory category unless there is evidence of an admission that the invention in the new statutory category format could not be patentable.. Authority for the proposition that an intentional admission is required to find that subject matter was surrendered can be found in *In re Clement*, citing *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984) and several cases listed in MPEP Section 1412.02. Thus, an amendment in a claim drafted in one statutory category to avoid prior art must not be presumed to be an admission that a “corresponding” claim in another statutory category has been surrendered. Rather, the recapture investigation should be directed to determining whether the claims are “corresponding.”

The Subcombination in Reissue Claims 22-26

Claim 1 of U.S. Patent 5,968,560 (underlining and paragraphing added) reads:

1. Device for manufacturing containers, made of a thermoplastic by blow molding or stretch-blow molding of a preheated preform, the said device including

at least one mold (1) consisting of two half-molds (2) respectively supported by two mold carriers (3) which are made in the form of enveloping structures and which can move one with respect to the other, characterized in that each half-mold (2) comprises

a shell holder (9) supported by the respective mold carrier (3) and
a shell (7) which is provided with a half-impression (8) of the container to be obtained and which can be removably fastened to its shell holder (9) by quick-fixing means (19-23),

the shell (7) and the shell holder (9) being in complementary shapes in order to be in at least partial mutual thermal-conduction contact while the pipes and connections for the circulation of cooling and/or heating fluids (11, 12) are provided exclusively in the shell holder.

Patent Claim 1 is directed to a *device* for manufacturing containers and includes the limitation “two half-molds . . . respectively supported by two mold carriers . . . which are made in the form of enveloping structures” Claims 22-26 of this reissue application (as amended) are directed to an *article*; that is, a mold assembly for use in manufacturing molded thermoplastic containers and includes a corresponding limitation “two mold shell holders . . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures.”

Step One. Turning to step one of the recapture test, Claims 22-26 are broader than patent Claim 1 only in statutory category (mold assembly article vs. manufacturing device). The same

characteristic that distinguished the invention from the prior art in patent Claim 1 (the mold carriers being in the form of enveloping structures) is a characteristic of the mold shell holders in reissue Claims 22-26 (they are shaped to be supported by mold carriers made in the form of enveloping structures). If an article subcombination claim corresponding to patent Claim 1 (without the axial positioning assembly) had been submitted in the original prosecution, and only the prior art then available had been considered, the subcombination claim would have been allowed for the same reasons the manufacturing device claim was allowed. Therefore, the only manner in which reissue Claims 22-26 are broader than patent Claim 1 stems directly from the difference in statutory category.

The shifting of the “enveloping structure” limitation from a characteristic of the mold carrier element in patent Claim 1 to a characteristic of the mold shell holders in reissue Claims 22-26 is a necessary result of shifting statutory claim categories, not a result of dropping a limitation added to overcome a rejection. The limitation remains in the reissue claims.

Reference to the MPEP discussion of “Reissue for Article Claims Which are Functional Descriptive Material Stored on a Computer-Readable Medium” clearly supports the Applicants’ position. The article limitation at issue in these reissue claims corresponds to the manufacturing device limitation in the same way that a software article claim limitation corresponds to a software process limitation in the example above. In the software example, an infringing disc maker need not carry out the steps of the process, but the recorded instructions must cause the steps to occur when the instructions are run on a computer. In the present case, a mold assembly maker need not provide the mold carriers, but the mold shell holders must be shaped to be supported by two mold carriers in the form of enveloping structures when the mold shell holders are used in a container manufacturing device. As in the case of the software example, the broadening in the present reissue is only in respect to the statutory claim category.

Step Two. The second step of the recapture test is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Here, the question is whether the Applicants surrendered the ability to claim the invention of patent Claim 1 as an article subcombination. There is no evidence in the record of the original prosecution from which to

infer such an admission. In the present Office Action, the Examiner does not address this issue. Instead, the Examiner concludes that because the mold carrier element of the patent claim was amended to overcome a prior art rejection, “the absence of [1] the mold carriers being in the shape of enveloping structures, [2] the at least one quick-fixing means and [3] in the case of claim 27 the shell holders from these claims constitutes recapture” (internal numbering added).

The limitation added to distinguish the prior art in the original prosecution has not been removed from the reissue claims. These claims do correspond to the patented container manufacturing device, and do not violate the recapture rule because there is no evidence the Applicants surrendered the broader aspect thereof.

In particular, the Applicants contend that reissue Claims 22-26 are narrower than the surrendered original claim in an aspect germane to the prior art rejection. Specifically, Claims 22-26 require “. . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures.” It cannot be denied that this limitation narrows the reissue claims as compared to the surrendered claim. And, these reissue claims are broader than the surrendered claim only in an aspect unrelated to the rejection. That is, they recast the invention as a corresponding article claim directed to the mold shell holder assembly. Therefore, because the Applicants did not surrender their ability to claim the invention in a claim directed to the mold shell holder, application of the test of *In re Clement* leads to the conclusion that the recapture rule does not bar these claims.

[2] The Quick-Fixing Means

The Examiner, in rejecting claims 22-26 as being an improper recapture of surrendered subject matter, also cited the absence of “the at least one quick-fixing means” The Examiner, however, pointed to no particular act or admission regarding the quick-fixing means during the prosecution of the original patent application as a basis for the rejection. An amendment of the mold carrier element of the patent claim does not create surrendered subject matter with respect to the quick-fixing means.

Step One. Claims 22-26 are broader than patent Claim 1 in that the shells are not described as having the capacity to be “removably fastened to its shell holder by quick-fixing means.”

Step Two. The second step of the recapture test is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Here, the question is whether the Applicants surrendered the ability to claim shells without describing them as having the capacity to be “removably fastened to its shell holder by quick-fixing means.” The Examiner points to no evidence of such a surrender in the record of the original prosecution. A review of the prosecution history reveals no act or admission in the record concerning the quick-fixing means from which to infer such a surrender.

Accordingly, because no subject matter related to the quick-fixing means was surrendered during prosecution of the original patent application, there can be no recapture attempt in the absence of the quick-fixing means from reissue claims 22-26.

[3] The Mold Shell

In rejecting claims 27-31, the Examiner cited the absence of the shell holders as being an improper recapture of surrendered subject matter. Claims 27-31 have been amended to recite a mold shell having coupling members “by which said mold shell can be fixed in an axial direction with respect to a mold shell holder, . . .” (Claim 27, as amended). The shell holder, as claimed, includes the shape limitation previously added during prosecution of the original patent. Because the mold shell as recited includes limitations relative to a shell holder, and because the shell holder includes the shape limitation, there is no recapture attempt in reissue claims 27-31.

The Subcombination in Reissue Claims 27-31

Like the subcombination recited in reissue claims 22-26, the subcombination recited in claims 27-31 is broader because the claims have been re-cast in a different statutory category. One way a reissue claim can be broadened is to recast it in a different statutory category. MPEP § 1412.02, at p. 1400-15.

Patent Claim 1 is directed to a *device* for manufacturing containers. Reissue Claims 27-31 are directed to an *article*; specifically, an article for use in manufacturing containers.

Patent Claim 1 includes “a shell holder (9) supported by the respective mold carrier (3).” Reissue Claims 27-31 (as amended) include a corresponding limitation, “by which said mold shell can be fixed in an axial direction with respect to a mold shell holder.”

Patent Claim 1 also includes the limitation “two half-molds . . . respectively supported by two mold carriers . . . which are made in the form of enveloping structures” Reissue Claims 27-31 (as amended) include a corresponding limitation “. . . said shell holders being shaped to be supported by two mold carriers made in the form of enveloping structures.”

Step One. Applying the first step of the recapture test, Claims 27-31 are broader than patent Claim 1 only in statutory category (an article vs. manufacturing device). The same characteristic that distinguished the invention from the prior art in patent Claim 1 (the mold carriers being in the form of enveloping structures) is a characteristic of the mold shell holders in reissue Claims 27-31 (they are shaped to be supported by mold carriers made in the form of

enveloping structures). If an article subcombination claim corresponding to patent Claim 1 had been submitted in the original prosecution, and only the prior art then available had been considered, the subcombination claim would have been allowed for the same reasons the manufacturing device claim was allowed. Therefore, the only manner in which reissue Claims 27-31 are broader than patent Claim 1 stems directly from the difference in statutory category.

The shifting of the “enveloping structure” limitation from a characteristic of the mold carrier element in patent Claim 1 to a characteristic of the mold shell holders in reissue Claims 27-31 is a necessary result of shifting statutory claim categories, not a result of dropping a limitation added to overcome a rejection. The limitation remains in the reissue claims.

Reference is again made to the MPEP discussion of “Reissue for Article Claims Which are Functional Descriptive Material Stored on a Computer-Readable Medium,” which clearly supports the Applicants’ position. The article limitation at issue in these reissue claims corresponds to the manufacturing device limitation in the same way that a software article claim limitation corresponds to a software process limitation in the example above. In the software example, an infringing disc maker need not carry out the steps of the process, but the recorded instructions must cause the steps to occur when the instructions are run on a computer. First, in the present case, a mold assembly maker need not provide the shell holders, but each mold shell must include coupling members by which the mold shell can be fixed in an axial direction with respect to a shell holder. Second, a mold assembly maker need not provide the mold carriers, but the shell holders if present must be shaped to be supported by two mold carriers in the form of enveloping structures when the shell holders are used in a container manufacturing device. As in the case of the software example, the broadening in the present reissue is only in respect to the statutory claim category.

Step Two. The second step of the recapture test is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. Here, the question is whether the Applicants surrendered the ability to claim the invention of patent Claim 1 as an article subcombination. There is no evidence in the record of the original prosecution from which to infer such an admission.

The limitation added in the original prosecution has not been removed from the reissue claims. These claims do correspond to the patented container manufacturing device, and do not violate the recapture rule because there is no evidence the Applicants surrendered the broader aspect thereof.

In particular, the Applicants contend that reissue Claims 27-31 are narrower than the surrendered original claim in an aspect germane to the prior art rejection. Specifically, Claims 27-31 require ". . . said shell holder being shaped to be supported by two mold carriers made in the form of enveloping structures." It cannot be denied that this limitation narrows the reissue claims as compared to the surrendered claim. And, these reissue claims are broader than the surrendered claim only in an aspect unrelated to the rejection. That is, they recast the invention as a corresponding article claim directed to the mold shell holder assembly. Therefore, because the Applicants did not surrender their ability to claim the invention in a claim directed to the mold shell holder, application of the test of *In re Clement* leads to the conclusion that the recapture rule does not bar these claims.

CONCLUSION

After entry of the requested amendment, claims 22-31 remain pending. In light of this amendment and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable and the application is now in condition for allowance.

A Petition and Fee for Extension of Time under 37 CFR § 1.136(a) is submitted herewith. The Applicants do not believe any fees for extensions of time or net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event, however, that additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account Number 16-0605.

Respectfully submitted,



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Shana Moore